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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REINHOLD SCHMIEDING

Appeal 2009-009983
Application 10/665,480
Technology Center 3700

Before JENNIFER D. BAHR, STEVEN D.A. McCARTHY, and
STEFAN STAICOVICI, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Reinhold Schmieding (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision finally rejecting under 35 U.S.C. § 112, first paragraph, claims 10-15 as failing to comply with the written description requirement and finally rejecting under 35 U.S.C. § 103(a) claims 10, 11 and 13-15 as unpatentable over Grooms (WO 99/21515, published May 6, 1999) (hereafter "Grooms I") and Chow (US 5,176,682, issued Jan. 5, 1993) and claim 12 as unpatentable over Grooms I, Chow, and Grooms (US 6,045,554, issued Apr. 4, 2000) (hereafter "Grooms II"). Claims 1-9 have been canceled. We have jurisdiction over this appeal under 35 U.S.C. § 6.

THE INVENTION

Appellant's invention relates to an implant for various surgical indications, including fixating tendon grafts in a joint using the implant in a transverse, intraosseous application. Spec. 3, ll. 8-10 and fig. 7A.

Claim 10, the sole independent claim, is representative of the claimed invention and reads as follows:

10. An implant for cross-pin anterior cruciate reconstruction surgery, comprising:

a proximal end;

a tapered distal end having a longitudinal axis and terminating in a pointed tip;

a transverse eye for receiving a flexible strand to draw said implant into an opening in bone, said transverse eye extending completely through said tapered distal end in a direction transverse to the longitudinal axis of the distal end, said transverse eye communicating with longitudinal channels formed on opposite sides of the implant and extending

completely from the transverse eye to the tip in a direction aligned with the longitudinal axis of the distal end; and

a solid rigid cylindrical shaft disposed between, and extending completely from, said proximal end to said tapered distal end, said solid rigid cylindrical shaft having a smooth cylindrical outer surface for supporting a graft in said opening in bone, the entire smooth cylindrical outer surface being parallel to a longitudinal axis of the shaft.

SUMMARY OF DECISION

We AFFIRM.

OPINION

The written description rejection

Appellant argues that “this issue is not ripe for appeal” because the Examiner has refused entry of the After-Final amendment, filed January 23, 2008. App. Br. 4. However, refusal of a Primary Examiner to enter an amendment, in whole or in part, is a petitionable matter, not an appealable matter, and is not within the jurisdiction of the Board. *See* MANUAL OF PATENT EXAMINING PROCEDURE (*MPEP*) §§ 1002.02(c)(3) and 1201. Since Appellant does not present any substantive arguments with respect to the rejection of claims 10-15 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, the rejection is summarily affirmed.

The obviousness rejection over Grooms I and Chow

With respect to the rejection of claim 10 over the combined teachings of Grooms I and Chow, Appellant first argues that (1) recess 18 of Chow is

not a “through hole” or a “transverse eye;” (2) channels 20a, 20b of Chow are not “in communication with a transverse eye” and are not “extending from a transverse eye to the tip of the implant;” and (3) Chow does not disclose “a tapered distal end.” App. Br. 6. *See also* Reply Br. 4-5. We disagree with Appellant’s position because this argument does not address the Examiner’s proposed combination. It appears that Appellant’s arguments are attacking the teachings of Grooms I and Chow individually, rather than the combination of Grooms I and Chow. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). In this case, the Examiner found, and we agree, that Grooms I discloses an implant having a transverse eye 210, a cylindrical shaft 204 and a tapered distal end adapted to receive a suture 201, and that the bone anchor of Chow includes a suture passage 18 having channels 20a and 20b formed around the hole (recess passage 18) and extending to the tip. Ans. 4. *See also*, Grooms I, fig. 2B and Chow, fig. 5.

Appellant further argues that one skilled in the art would not have been motivated to combine the demineralized/mineralized bone segments of Grooms I with the surgical implement of Chow. App. Br. 7-8. *See also* Reply Br. 6. Specifically, Appellant argues that the surgical implement of Chow is “provided with flexible fins that are ‘forced outwardly’ into the bone hole” and that “the demineralized/mineralized bone segments of Grooms [I] would not withstand any force exerted by such fins.” App. Br. 8. *See also* Reply Br. 6. We are not persuaded by Appellant’s argument, because obviousness does not require that all of the features of the secondary

reference be bodily incorporated into the primary reference. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). As noted by the Examiner, the disclosure of Chow was used to merely show channels 20a and 20b. Ans. 6.

Lastly, Appellant argues that, “[a]s Grooms [I] does not teach that suture stress on its demineralized segment is a problem, or even exists, one skilled in the art would not have been motivated to combine the teachings of Chow to solve a problem that does not exist.” Reply Br. 7. We find Appellant’s argument unpersuasive because this argument is foreclosed by *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), in which the Court rejected the rigid requirement of a teaching, suggestion or motivation to combine known elements in order to show obviousness. *KSR* at 415. If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Id.* at 417. In determining whether the subject matter of a claim is obvious, “neither the particular motivation nor the avowed purpose of the [applicant] controls. What matters is the objective reach of the claim.” *Id.* at 419. If the claim extends to what is obvious, it is unpatentable under § 103. *Id.* Moreover, while there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, the analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418.

In this case, the Examiner found, and we agree, that Grooms I discloses an implant 200 comprising a blunt proximal end 202, a tapered

distal end 201, a transverse eye 210 for receiving a suture, wherein the transverse eye 210 extends completely through tapered distal end 201, and a cylindrical shaft 204. Ans. 4. *See also* Grooms I, P. 4, ll. 27-32 and fig. 2B. We further agree with the Examiner that Chow discloses a bone anchor 10 comprising a transverse recess 18 and longitudinal channels 20a, 20b formed on opposite sides of bone anchor 10, which communicate with transverse recess 18 and which extend completely from the transverse recess 18 to the end (tip) of bone anchor 10. Ans. 4 and 6. *See also* Chow, col. 2, ll. 67-68, col. 3, ll. 7-10 and figs. 5 and 6. Chow further discloses that bone anchor 10 can be used in intercrucial ligament surgery and that ligament/suture L is captured and held in place by transverse recess 18 and longitudinal channels 20a, 20b of body 12 in order to prevent the ligament/suture L from being dislodged. Chow, col. 2, ll. 43-44, col. 3, ll. 7-10 and 36-38 and figs. 5 and 6. Hence, a person of ordinary skill in the art would have readily appreciated that incorporating the longitudinal channels, as taught by Chow, would provide the same benefit to the bone implant of Grooms I, namely, to prevent the suture from being displaced. As such, Appellant's claimed bone implant is nothing more than the bone implant of Grooms I including the longitudinal channels of Chow. Modifying the bone implant of Grooms I to include the longitudinal channels, as taught by Chow, would not have been uniquely challenging to a person of ordinary skill in the art, because it is no more than "the mere application of a known technique to a piece of prior art ready for the improvement." *KSR* at 417. In conclusion, we agree with the Examiner that it would have been obvious to modify the bone implant of Grooms I with the longitudinal channels of Chow to provide "a smoother

guide surface for the suture thread around the through hole [of Grooms I] thereby relieving stress on the suture.” Ans. 4 and 6.

Accordingly, for the foregoing reasons, the rejection of claim 10 under 35 U.S.C. § 103(a) as unpatentable over Grooms I and Chow is sustained.

With respect to claims 11, 13 and 15, Appellant merely reiterates the claim limitations and does not present separate arguments for patentability of these claims. App. Br. 7. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”). Therefore, the rejection of claims 11, 13 and 15 is likewise sustained.

Regarding claim 14, Appellant argues that Grooms I and Chow, alone or in combination, fail to disclose that “the channels are configured to accommodate the suture received in the eye of the implant to prevent binding of the suture as the implant is inserted into the bone.” App. Br. 7. *See also* App. Br., Claims Appendix. According to Appellant, “[c]hannels 20a, 20b of Chow allow a ligament to be captured within recess 18, and are not configured to accommodate [a] suture that is received in the transverse eye and that extends from the eye to the tip of the implant through longitudinal channels.” App. Br. 7.

We find Appellant’s arguments unpersuasive because the limitation of the channels being “configured to accommodate the suture received in the eye of the implant,” as called for in claim 14, is functional language as it describes the “intended use” of the channels as opposed to a structural element of the implant. *See* Ans. 6. “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb*

Inc., 909 F.2d 1464, 1468 (Fed. Cir. 1990). Therefore, as long as the channels of Grooms I and Chow are capable of accommodating the suture received in the eye of the implant, the implant device of Grooms I and Chow meets the limitations of claim 14. Chow discloses that ligament or suture L is captured and held in place by transverse recess 18 and longitudinal channels 20a, 20b in order to prevent the ligament or suture L from being dislodged. Chow, col. 2, ll. 43-44, col. 3, ll. 7-10 and 36-38 and figs. 5 and 6. Hence, in view of Chow's disclosure, we agree with the Examiner that the channels of Grooms I, as modified in view of Chow, are capable of accommodating the suture received in the eye of the implant, as called for by claim 14. Ans. 6. Appellant has not provided any evidence to the contrary. An attorney's arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Accordingly, for the foregoing reasons, the rejection of claim 14 as unpatentable over Grooms I and Chow is sustained.

The obviousness rejection over Grooms I, Chow and Grooms II

Claim 12 requires, "the implant is formed of synthetic bone material." App. Br. 8. *See also* App. Br., Claims Appendix. Appellant argues that Grooms II discloses an "interference screw" and not an "implant for cross-pin anterior cruciate reconstruction surgery." App. Br. 8. We disagree with Appellant's position because this argument does not address the Examiner's proposed combination. Once more, Appellant appears to be attacking the teachings of Grooms I, Chow, and Grooms II individually, rather than the combination of Grooms I, Chow, and Grooms. As discussed above, the combination of Grooms I and Chow shows an implant as called for in claim

10. The disclosure of Grooms II was used by the Examiner to merely show an implant made from allograft or synthetic bone material. Ans. 5, 6. As such, since Appellant does not contest the Examiner's proposed combination of Grooms I, Chow, and Grooms II and does not present any additional arguments, the rejection of claim 12 under 35 U.S.C. § 103(a) as unpatentable over Grooms I, Chow, and Grooms II is sustained.

DECISION

The decision of the Examiner is affirmed as to claims 10-15.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

mls

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